



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,600	12/17/1999	ALEX I. EYDELBERG	INTL-0304-US	9073
21906	7590	10/18/2006	EXAMINER	
TROP PRUNER & HU, PC 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			HA, LEYNNA A	
			ART UNIT	PAPER NUMBER
			2135	

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/465,600

Applicant(s)

EYDELBERG, ALEX I.

Examiner

LEYNNA T. HA

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31-37, 39-41, 43-51, 53, and 55-63 is/are pending in the application.
- 4a) Of the above claim(s) 1-30, 38, 42, 52 and 54 is/are ~~withdrawn from consideration~~ *canceled*.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-37, 39-41, 43-51, 53 and 55-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 31-37, 39-41, 43-51, 53, and 55-63 remain pending.
2. This is a Non-Final rejection.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 40-41 and 43-50 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claim 40 recites "an article comprising a medium for storing instructions that cause a system". The claimed article is nothing more than a carrier for non-functional descriptive material. All other dependent claims are also rejected due to dependency.

#### ***MPEP:***

##### **(b) Nonfunctional Descriptive Material**

Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C.101. Thus, Office personnel should consider the claimed invention as a whole to determine whether the necessary functional interrelationship is provided. Where certain types of descriptive material,

Art Unit: 2135

such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. (Data consists of facts, which become information when they are seen in context and convey meaning to people. Computers process data without any understanding of what that data represents. Computer Dictionary 210 (Microsoft Press, 2d ed. 1994).) The policy that precludes the patenting of nonfunctional descriptive material would be easily frustrated if the same descriptive material could be patented when claimed as an article of manufacture. For example, music is commonly sold to consumers in the format of a compact disc. In such cases, the known **compact disc acts as nothing more than a carrier for nonfunctional descriptive material**. The purely nonfunctional descriptive material cannot alone provide the practical application for the manufacture. Office personnel should be prudent in applying the foregoing guidance. **Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101**. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claims 31-37, 39-41, 43-51, 53, and 55-63 are rejected under 35 U.S.C. 103(a) as being unpatentable by Woodruff (US 6,438,711) in further view of Anderson (US 6,161,177).**

**As per claim 31:**

Woodruff discloses a method comprising:

determining a system state indicative of whether a system is connected to a network; [col.3, lines 3-4; Woodruff discusses determining a system state when it recognized a connection to a network (the remote management console) have been established.]

loading either a first module of a basic input/output system or a second module of the basic input/output system based on the system state; and [col.3, lines 5-6 and col.6, lines 8-21; based on the system state which is a connection to a network (the remote management console), the boot strap loader puts the computer system in a diagnostic state (col.3, lines 1-2). The boot strap loader module is then loaded to provide session manager, session authorizer, system status handler, and data handler (col.5, lines 44-46 and 56-57 and col.6, lines 8-10 and 22-23). Woodruff discloses various modules of a BIOS such as the initialization module that handles the components aspect (col.5, lines

16-25), the operating system boot module that is executed when it is determined that no diagnostic session request are being made (col.6, lines 37-42), and the boot strap loader module that handles the session aspect (col.5, lines 29-67) once a connection to the remote management console has been determined. Thus, any of the BIOS modules as taught by Woodruff can be the claimed first or the second module of BIOS.]

requesting a first level of authentication information or a second level of authentication information from a user based on the system state. [col.5, lines 56-67; The claimed first level or second level of authentication does not limit what involves in the first level and what is considered a second level of authentication information. Thus, the examiner will apply the first level of authentication information as Woodruff teaching a diagnostic session password. Woodruff discusses based system state that once the connection has been established and loading the boot strap loader module, the session authorizer determines whether the remote management console is authorized by transmitting the first level of authentication information such as a diagnostic session password. The diagnostic session password is requested along with a diagnostic session request message that then would be compared with to determine whether the remote management console has authorization.]

Woodruff discusses the loading of (second) boot loader module based on the system state which is once a connection to the remote management console have been established and may request a specific version of the BIOS (col.7, lines 30-33 and col.8, lines 60-64). Thus, Woodruff loading the boot loader module reads on the claimed loading either a first module of the BIOS or a second module of BIOS based on a system state because a second module of the BIOS is loaded once it is recognized a connection to the remote console has been established (col.3, lines 1-5). The claimed

fails to limit whether the invention has an option to choose or decide to load one module from amongst the two modules. However, to cover this limitation that might entail the claimed invention, the examiner brings forth a secondary art to overcome the obviousness.

Anderson teaches a computer system that includes a memory device containing a BIOS program and BIOS identifying data specifying the CPU corresponding to the BIOS program (col.2, lines 50-62). The BIOS can be stored and read from the memory device, disk drive, EEPROM (col.3, lines 10-22 and col.4, lines 19-21). Further, Anderson teaches determining if the correct BIOS has been selected for execution by the CPU (col.4, lines 41-43 and col.5, lines 22-30).

Therefore, it would have been obvious of the ordinary skill in the art to combine the teaching of loading a BIOS module based on a system state indicative of whether a system is connected to a network of Woodruff with Anderson of either loading the first or second BIOS is to ensure that the proper BIOS program is executed in computer systems having more than one BIOS program retained in a storage device and such will add optimum performance (col.2, lines 45-63).

**As per claim 32:** Woodruff discloses a method of claim 1 further comprising:

storing said first module of a basic input/output system on a first storage device prior to execution; [col.5, lines 10-11]

storing said second module of the basic input/output system on a second storage device prior to execution; and [col.6, lines 50-54]

enabling said second module to be executed conditionally depending on a state.

[col.3, lines 5-6 and col.6, lines 8-21]

**As per claim 33:** see Woodruff on col.2, lines 12-13 and 17-18 and col.4, lines 35-40; discussing storing said second module includes storing said second module in a storage associated with a network server accessible to said system over the network.

**As per claim 34:** see Woodruff on col.3, lines 2-5; discussing detecting whether or not the system is connected to the network during a boot sequence.

**As per claim 35:** see Woodruff on col.5, lines 16-35; discusses dynamically linking to one of a plurality of modules, and exporting and offset to an entry point in one module to another module.

**As per claim 36:** see Woodruff on col.7, lines 6-25; discusses storing a secondary entry point in a module to locate a function within the module.

**As per claim 37:** see Woodruff on col.7, lines 37-44 and Anderson on col.1, lines 65-67; discusses developing a segment address for said second module at run time.

**As per claim 38:** Cancelled.

**As per claim 39:** see Woodruff on col.5, lines 56-67; discusses authenticating a user according to one of multiple levels based upon the system state, and obtaining a key from a protected storage if the user is authenticated.

**As per claim 40:**

Woodruff discloses an article comprising a medium for storing instructions that cause a system to:



determining a system state indicative of whether a system is connected to a network; [col.3, lines 3-4; Woodruff discusses determining a system state when it recognized a connection to a network (the remote management console) have been established.]

loading either a first module of a basic input/output system or a second module of the basic input/output system based on the system state; and [col.3, lines 5-6 and col.6, lines 8-21; based on the system state which is a connection to a network (the remote management console), the boot strap loader puts the computer system in a diagnostic state (col.3, lines 1-2). The boot strap loader module is then loaded to provide session manager, session authorizer, system status handler, and data handler (col.5, lines 44-46 and 56-57 and col.6, lines 8-10 and 22-23). Woodruff discloses various modules of a BIOS such as the initialization module that handles the components aspect (col.5, lines 16-25), the operating system boot module that is executed when it is determined that no diagnostic session request are being made (col.6, lines 37-42), and the boot strap loader module that handles the session aspect (col.5, lines 29-67) once a connection to the remote management console has been determined. Thus, any of the BIOS modules as taught by Woodruff can be the claimed first or the second module of BIOS.]

request a first level of authentication information or a second level of authentication information from a user based on the system state. [col.5, lines 56-67; The claimed first level or second level of authentication does not limit what involves in the first level and what is considered a second level of authentication information. Thus, the examiner will apply the first level of authentication information as Woodruff teaching a diagnostic session password. Woodruff discusses based system state that once the connection has been established and loading the boot strap loader module, the session

**authorizer determines whether the remote management console is authorized by transmitting the first level of authentication information such as a diagnostic session password. The diagnostic session password is requested along with a diagnostic session request message that then would be compared with to determine whether the remote management console has authorization.]**

Woodruff discusses the loading of (second) boot loader module based on the system state which is once a connection to the remote management console have been established and may request a specific version of the BIOS (col.7, lines 30-33 and col.8, lines 60-64). Thus, Woodruff loading the boot loader module reads on the claimed loading either a first module of the BIOS or a second module of BIOS based on a system state because a second module of the BIOS is loaded once it is recognized a connection to the remote console has been established (col.3, lines 1-5). The claimed fails to limit whether the invention has an option to choose or decide to load one module from amongst the two modules. However, to cover this limitation that might entail the claimed invention, the examiner brings forth a secondary art to overcome the obviousness.

Anderson teaches a computer system that includes a memory device containing a BIOS program and BIOS identifying data specifying the CPU corresponding to the BIOS program (col.2, lines 50-62). The BIOS can be stored and read from the memory device, disk drive, PROM, EEPROM (col.3, lines 10-22 and col.4, lines 19-21). Further, Anderson teaches determining if the correct BIOS has been selected for execution by the CPU (col.4, lines 41-43 and col.5, lines 22-30).

Therefore, it would have been obvious of the ordinary skill in the art to combine the teaching of loading a BIOS module based on a system state indicative of whether a system is connected to a network of Woodruff with Anderson of either loading the first or second BIOS is to ensure that the proper BIOS program is executed in computer systems having more than one BIOS program retained in a storage device and such will add optimum performance (col.2, lines 45-63).

**As per claim 41:** Woodruff discloses a method of claim 1 further comprising:

access said first module of a basic input/output system on a first storage device;

[col.5, lines 10-11]

access said second module of the basic input/output system on a second storage device; and [col.6, lines 50-54]

execute said second module conditionally depending on a state. [col.3, lines 5-6 and col.6, lines 8-21]

**As per claim 42:** Cancelled.

**As per claim 43:** see Woodruff on col.3, lines 2-5; discusses storing instructions that cause a system to execute said second module conditionally depending on whether or not the system is coupled to the network.

**As per claim 44:** see Woodruff on col.3, lines 5-6 and col.6, lines 8-21 and 50-54; discusses storing instructions that cause a system to selectively access either a first module setting forth a first authentication protocol in the first storage device or a second module setting forth a second authentication protocol in the second storage device based on the system state.

Art Unit: 2135

**As per claim 45:** see **Woodruff** on **col.5, lines 56-67**; discusses storing instructions that cause a system to obtain a key from a protected storage if a user is authenticated.

**As per claim 46:** see **Woodruff** on **col.6, lines 50-54**; discusses storing instructions that cause a system to dynamically link said first and second modules.

**As per claim 47:** see **Woodruff** on **col.2, line 66 – col.3, line 5**; discusses storing instructions that cause a system to detect whether the system is connected to the network during a boot sequence.

**As per claim 48:** see **Woodruff** on **col.5, lines 16-35**; discusses storing instructions that cause a system to dynamically link to one of a plurality of modules using offsets to entry points in said modules.

**As per claim 49:** see **Woodruff** on **col.7, lines 6-25**; discusses storing instructions that cause a system to store a secondary entry point in a module to locate a function within the module.

**As per claim 50:** See **Woodruff** on **col.7, lines 37-44** and **Anderson** on **col.1, lines 65-67**; discusses storing instructions that cause a system to develop a segment address for said second module at run time.

**As per claim 51:**

Woodruff discloses a system comprising:

a first basic input/output system module stored in a first storage of the system, the first basic input/output system module executable by a processor; and [col.5, lines 10-11]

a second basic input/output system module stored in a second storage of the system, the second basic input/output system module executable by said processor; and [col.6, lines 50-57]

the processor to load either said first basic input/output system module or said second basic input/output system module based on a system state that indicates a connection to a network. [col.3, lines 5-6 and col.6, lines 8-21; based on the system state which is a connection to a network (the remote management console), the boot strap loader puts the computer system in a diagnostic state (col.3, lines 1-4). The boot strap loader module is then loaded to provide session manager, session authorizer, system status handler, and data handler (col.5, lines 44-46 and 56-57 and col.6, lines 8-10 and 22-23). Woodruff discloses various modules of a BIOS such as the initialization module that handles the components aspect (col.5, lines 16-25), the operating system boot module that is executed when it is determined that no diagnostic session request are being made (col.6, lines 37-42), and the boot strap loader module that handles the session aspect (col.5, lines 29-67) once a connection to the remote management console has been determined. Thus, any of the BIOS modules as taught by Woodruff can be the claimed first or the second module of BIOS.]

Woodruff discusses the loading of (second) boot loader module based on the system state which is once a connection to the remote management console have been established and may request a specific version of the BIOS (col.7, lines 30-33 and col.8, lines 60-64). Thus, Woodruff loading the boot loader module reads on the claimed loading either a first module of the BIOS or a second module of BIOS based on a system state because a second module of the BIOS is loaded once it is recognized a

Art Unit: 2135

connection to the remote console has been established (col.3, lines 1-5). The claimed fails to limit whether the invention has an option to choose or decide to load one module from amongst the two modules. However, to cover this limitation that might entail the claimed invention, the examiner brings forth a secondary art to overcome the obviousness.

Anderson teaches a computer system that includes a memory device containing a BIOS program and BIOS identifying data specifying the CPU corresponding to the BIOS program (col.2, lines 50-62). The BIOS can be stored and read from the memory device, disk drive, EEPROM (col.3, lines 10-22 and col.4, lines 19-21). Further, Anderson teaches determining if the correct BIOS has been selected for execution by the CPU (col.4, lines 41-43 and col.5, lines 22-30).

Therefore, it would have been obvious of the ordinary skill in the art to combine the teaching of loading a BIOS module based on a system state indicative of whether a system is connected to a network of Woodruff with Anderson of either loading the first or second BIOS is to ensure that the proper BIOS program is executed in computer systems having more than one BIOS program retained in a storage device and such will add optimum performance (col.2, lines 45-63).

**As per claim 52: Cancelled.**

**As per claim 53: see col.5, lines 16-67 - Woodruff discloses various modules of a BIOS such as the initialization module that handles the components aspect (col.5, lines 16-25), the operating system boot module that is executed when it is determined that no diagnostic session request are being made (col.6, lines 37-42), and the boot strap loader module that handles the session aspect (col.5, lines 29-67) once a connection to the**

Art Unit: 2135

remote management console has been determined. Thus, any of the BIOS modules as taught by Woodruff can be the claimed first, second, or the third module of BIOS.; discusses a third basic input/output module stored in a third storage, said third storage being coupled to said system over the network.

**As per claim 54: Cancelled.**

**As per claim 55: see Woodruff on col.5, lines 56-67;** discusses first and second basic input/output module modules include different authentication protocols.

**As per claim 56: see Woodruff on col.5, lines 56-67;** discusses processor to execute said second basic input/output system module to implement a network authentication protocol.

**As per claim 57: see Woodruff on col.5, lines 56-67;** the first level of authentication information is greater than the second level of authentication information and further comprising requesting the first level of authentication information if the system is connected to the network.

**As per claim 58: see Woodruff on col.4, lines 32-35 and Anderson on col.3, lines 10-22;** a fourth basic input/output system module stored in a fourth storage.

**As per claim 59: see Woodruff on col.4, lines 33-35 and Anderson on col.3, lines 19-21;** a card reader coupled to the processor, the card reader to read a card, wherein the card comprises the fourth storage.

**As per claim 60: see Woodruff on col.2, lines 12-14 and Anderson on col.3, lines 19-21 (it is obvious a smart card can be the disclosed computer system or**

Art Unit: 2135

**laptop or video camera where a card may be inserted);** the fourth storage comprises a smart card.

**As per claim 61:** see Woodruff on col.5, lines 56-67; executing the loaded one of the first basic input/output system module or the second basic input/output system module to request the authentication information from the user and authenticate the user.

**As per claim 62:** see Woodruff on col.5, lines 56-67 and col.2, lines 12-14 and Anderson on col.3, lines 19-21 (it is obvious a smart card can be the disclosed computer system or laptop or video camera where a card may be inserted); the first level of authentication information includes presence of a smart card in the system.

**As per claim 63:** see Woodruff on col.7, lines 18-30; authenticating the user a second time after an operating system is loaded.

### ***Response to Arguments***

**5. Applicant's arguments filed 7/21/06 have been fully considered but they are not persuasive.**

Claims 31-37, 39-41, 43-51, 53, and 57-63 are now rejected over Woodruff and Anderson.



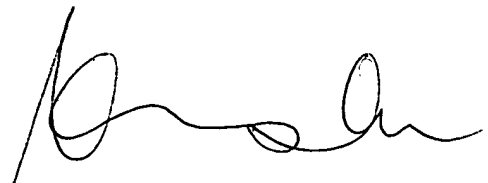
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEYNNA T. HA whose telephone number is (571) 272-3851. The examiner can normally be reached on Monday - Thursday (7:00 - 5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LHa



**KIM VU**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**